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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,595	08/26/2003	Richard N. Terry	02706-0528 (42276-291519)	4976
24504	7590	09/06/2005	EXAMINER	
THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 100 GALLERIA PARKWAY, NW STE 1750 ATLANTA, GA 30339-5948			SZEKELY, PETER A	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/649,595

Applicant(s)

TERRY, RICHARD N.

Examiner

Peter Szekely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-37 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 26 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. This application lacks the necessary reference to prior application; it may constitute a continuation-in-part of the prior applications. The current status of all non-provisional parent applications referenced should be included.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1, 5, 8, 9, 16, 20, 21, 27, 30 and 32-37 are, rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1, 5, 8, 20, 21, 30 and 33-37 contain improper Markush language.

Whenever in a list of alternatives the last conjunction is "and", the required language is "selected from the group consisting of". Always. Without exception. As the paragraph of the M.P.E.P. quoted by applicant states "When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, *or alternatively*." This means that if applicant decides to avoid the use the proper Markush language, the last conjunction has to be "or", not "and". The rejection is maintained.

5. Claims 9 and 16 are rendered indefinite by the expression "between about". It has to be either "between " or "about". See *Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.*, 18 USPQ2d 1016 (Fed. Cir. 1991). "From about-to about" is acceptable.

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6. The terms "high water solubility and low water solubility" in claims 27 and 32 are relative terms which render the claims indefinite. The terms "high water solubility and low water solubility" are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The limits of high and low water solubility have not been established.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of U.S. Patent No. 6,716,895. Although the conflicting claims are not identical, they are not patentably distinct from each other because "one or more" includes "a plurality".

9. Claims 1-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,596,401. Although the conflicting claims are not identical, they are not patentably

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distinct from each other because oligodynamic metal salts are one of the alternative active agents.

10. Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 41, 43-52 and 56-58 of copending allowed Application No. 10/212,505. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compositions overlap.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 1-8, 10, 11, 13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kissel 5,173,531, Usuki et al. 5,728,781 or Morris et al. 6,063,849.

13. All references have been discussed previously. The compositions of Usuki et al. and Morris et al. are coated on a surface. See claim 1 of Usuki et al. and claim 13 of Morris et al. The shower curtains of Morris et al. (column 1, line 22) are transparent. The intended use has no patentable significance. Applicant failed to prove that the cited references disclose formulations, which cannot be coated on medical devices.

14. Claims 1-11 and 13-37 are rejected under 35 U.S.C. 102(b or e) as anticipated by Dresdner, Jr. et al. 5,357,636, Gibbins 6,355,858 or Terry et al. 6,596,401.

15. Dresdner, Jr. has been discussed already. A protective medical glove is a medical device. Terry et al has been discussed previously also. Since both the oligodynamic metal salts and oxides and the medical devices are claimed in claims 1-20, the rejections imposed in the previous Office action were proper and are maintained, in spite of the 132 Declaration filed 8/11/05. Contact lenses (claim 18) are transparent. Gibbins ('858) teaches a wound-dressing device in claim 1, silver salts in claim 14, polymers in column 8, lines 3-21 and colloidal silver chloride in Example 8. The solubilities are inherent in the composition. Applicant's claims are not novel.

Claim Rejections - 35 USC § 103

16. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

17. Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kissel 5,173,521, Dresdner, Jr. 5,375,636, Usuki et al. 5,728,781, Morris et al. 6,063,849, Gibbins 6,355,858 or Terry et al. 6,596,401.

18. All references have been described already. The examiner holds that partially coating an article is a matter of choice, and as such, it would have been patently obvious to one having ordinary skill in the art; at the time the invention was made.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (571) 272-1124. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Peter Szekely
Primary Examiner
Art Unit 1714

P.S.
9/1/05